REMARKS

Claims 50-62 were pending in the application of which claims 50 and 57 were independent claims. No claims have been added, amended, or canceled. Accordingly, claims 50-62 are still pending of which claims 50 and 57 are independent claims.

A.   Claim Rejection under 35 U.S.C. § 112

Paragraph 3 of the Action rejects claims 50 and 57 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to point out and distinctly claims the subject matter. Applicant traverses the rejection.

More specifically, the Action misinterprets the word "online" as used in claims 50 and 57. The Action states that the word "online" is used to mean "not connected" in claims 50 and 57. Applicant strongly disagrees.

The term "online" in claim 50 and 57 reflects a status that a wireless communication device *is connected.* See Claim 50, which in relevant part states, "[the proxy server is used to] indicate that the wireless communications device is *online (e.g. is connected)* even when a data connection does not exist between the wireless communication device and the wireless network".

Similarly, claim 57 uses "on-line" to reflect that the proxy server is a stand in "on-line" (e.g. connected) presence. Thus, the wireless can appear "connected" even when it is not. Accordingly, Applicant respectfully submits that claims 50 and 57 meet the requirements of 35 USC §112, second paragraph and respectfully requests withdrawal of the rejection.

B.   Claim Rejections under 35 U.S.C. § 103:

1.   Rejection of Claims 50-56 under 35 U.S.C. §103(a) over Carey in view of Gudjonsson.

Paragraph 6 of the Action rejects claims 50-56 under 35 U.S.C. 103(a) as being unpatentable over Carey (US 6,714,792 B1) in view of Gudjonsson (US 6,564,261 B1). With respect to claims 50-56, Applicant respectfully traverses the

rejection because Carey in view of Gudjonsson fails to make out a prima facie case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to allege a claim is obvious when references are combined under 35 U.S.C. 103(a) the combination must teach each and every limitation of the claim. In this case, the rejection must fail because Carey in view of Gudjonsson alone or in combination, fail to teach each and every element of the claims as amended.

Further, as the Federal Circuit has made clear, the first two criteria inform the prongs of the three-way test referred to in *Graham v. John Deere* in order to prevent the reliance on impermissible hindsight. In this case, the references fail to provide a proper motivation to combine the references or reasonable expectation of success. Accordingly, with respect to claims 50-56 the rejection must fail and is at best based on improper hindsight.

Certain embodiments of the present application are directed to a system for providing a wireless communications device access to an instant messaging service on a data network. For instance, independent claim 50 is directed to system in which a "proxy server" or any other type of server can maintain the presence information of the wireless communication device with an instant messaging service such that the wireless communications device appears "online" even when in fact there is NO "data connection" between the wireless communication device and the wireless network. Prior art systems, including

those described in the art cited in the Action, simply do not make a wireless device appear online, without a data connection to the device.

Prior Actions acknowledge the Carey et al. reference does not teach this limitation (See non-Final Office Action of February 6, 2007); however, the Action states the Examiner's opinion that this limitation was well known in the art and cites the teachings of Gudjonsson as evidence in support of his opinion.

Applicant respectfully asserts that this limitation was not well known, and a close examination of Gudjonsson reveals that it does not in fact support the Examiner's opinion. Rather, Gudjonsson fails to cure the deficiencies of Carey. The sections (col. 7, line 53 – col. 8, line 30; col. 8, lines 53-65, col. 11 lines 32-64) of Gudjonsson et al. offered by the Action of July 24, 2007 merely teach connection servers (col. 8, lines 19-21) that provide services such as: storing "presence data" associated with a user on a database (col. 8, lines 54-56), publishing dynamic user status information **to indicate** "whether the user is currently online on his/her PC or not" (col. 8, lines 57-60), and providing users with the ability **to check** whether other users are connected to the same connection servers are online (col. 8, lines 61-63).

In fact, a close look at each of the cited passages reveals the repeated emphasis within Gudjonsson on the need for the devices to be connected in order to establish, maintain, and monitor presence information. For example, column 2, lines 20-22, states "status is usually defined as whether a user is **currently connected to the network** or not." Column 7, line 53 to column 8 line 30, and more specifically col. 8, lines 18-23, states "[e]xternal users 7 and their respective client devices 11 . . . can **connect** to services within the cluster via a special connection service, that typically runs on serve(s) (connection servers) at the boundary of the cluster's firewall 9, and listens for **connections** on a specific port." Column 8, lines 53-56, and more particularly lines 53-56, state that the user (not a proxy for the user) has "the ability to define arbitrary sets of data related to that identity . . . and this data is referred to herein as "presence" data of the user." Column 11, lines 32-64, and more particularly lines 38-39, states "the client 11

connects to the corresponding server 3 and establishes a secure **connection** with it."

Nowhere, and certainly not in the text cited in the action, does Gudjonsson disclose maintaining presence for a user even when that user is not connected. Gudjonsson discloses at column 3, lines 14-17 that "the routing service allows users to send invitations to other users to establish an arbitrary communication session . . . over arbitrary networks." But even here it does not say that the routing service or a server will maintain presence on behalf of a user even when that user is not connected.

Accordingly, Carey and Gudjonsson, alone or in combination, do not teach all of the limitations of claim 50, nor does Gudjonsson provide any motive to modify the teachings of Carey to achieve the invention as claimed in claim 50. Claims 51-55 depend from claim 50 and are allowable for the at least the same reasons as claim 50. Applicant therefore respectfully request withdrawal of the rejection of claims 50-55.

Furthermore, claim 56 depends on claim 50 and adds "wherein the proxy server receives an indication that the wireless communications device is in an inactive state, and wherein the proxy server removes the substitute proxy server presence upon receipt of the indication that the wireless communications device in the inactive state." The Action alleges that Carey teaches this limitation; however, if Carey does not teach the substitute proxy presence of claim 50, as admitted in the Action, then it cannot teach this additional limitation of claim 56. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 56.

2. Rejection of Claims 57-62 under 35 U.S.C. §103(a) over Carey in view of Gudjonsson in further view of Polychronidis.

The Action rejects claim 57 on similar grounds as claim 50 and combines Carey and Gudjonsson in a similar manner as with respect to claim 50. Claim 57 is directed to similar subject matter as claim 50. Accordingly, claim 57 is allowable over the combination of Carey and Gudjonsson for similar reasons as claim 50.

Polychronidis also fails to cure the deficiencies of Carey in light of Gudjonsson and the Action does not allege anything to the contrary. Polychronidis merely teaches a push or pull agent that accepts queries for presence/location information from an application. (See pg. 3, paragraph 34-35, 37.) The pull agent then queries the Home Location Register (HLR) of the wireless network for the requested information, and relays this information to the application. (Id.)

Accordingly, Carey, Gudjonsson and Polychronidis, alone or in combination, do not teach all of the limitations of claim 57, nor does Gudjonsson or Polychronidis provide any motive to modify the teachings of Carey to achieve the invention as claimed in claim 57. Claims 58-62 depend from claim 57 and are allowable for the at least the same reasons as claim 57. Applicant therefore respectfully request withdrawal of the rejection of claims 57-62.

3.   Rejection of Claims 50 and 57 under 35 U.S.C. §103(a) over Carey in view of Guedalia.

In this rejection, the Action attempts to plug Guedalia into the hole that Gudjonsson could not fill with respect to the teachings of Carey. But Guedalia also fails to cure the deficiencies of Carey. Guedalia merely teaches a presence server that "maintains an active session" with an external server (i.e., instant messaging service) even when a user is disconnected from the presence server (col. 5, lines 4-10). There is no teaching or suggestion in Guedalia that the presence server "actively" transmits presence information to the external server (i.e., instant messaging service) to fool it into thinking that the user (i.e. wireless communications device) is online even when he/she is disconnected from the presence server. The fact that an "active session" is maintained by the presence server cannot be inferred to mean that the presence server is actively transmitting presence information to the external server. They are mutually exclusive concepts.

Accordingly, Carey and Guedalia, alone or in combination, do not teach all of the limitations of claims 50 and 57, nor does Guedalia provide any motive to modify the teachings of Carey to achieve the invention as claimed in claims 50

and 57. Applicant therefore respectfully request withdrawal of the rejection of claims 50 and 57.

4.   Rejection of Claims 50 and 57 under 35 U.S.C. §103(a) over Carey in view of Chen in further view of Polychronidis.

In this rejection, the Action attempts to plug Chen into the hole that Gudjonsson and Guedalia could not fill with respect to the teachings of Carey. But Chen too also fails to cure the deficiencies of Carey. The section of Chen cited in the Action (col. 1, lines 63-65 and FIGs 1 and 4) merely teaches that a proxy server, between a wireless device and one or more network servers, can facilitate the transmission of SMS messages. Chen is completely silent as to the proxy server having any capability of actively transmitting presence information to the one or more of the network servers to indicate that the wireless device is online even when the wireless device is disconnected from the proxy server.

Accordingly, Carey, Chen and Polychronidis, alone or in combination, do not teach all of the limitations of claims 50 and 57, nor does Chen or Polychronidis provide any motive to modify the teachings of Carey to achieve the invention as claimed in claims 50 and 57. Applicant therefore respectfully request withdrawal of the rejection of claims 50 and 57.

CONCLUSION

Applicants believe that no additional fees are necessitated by this response. The Commissioner is hereby authorized to charge any additional fees required by this response to our **Deposit Account No. 50-3001 of Kyocera Wireless Corp.** (Attorney Docket No. UTL 00015).

Respectfully Submitted;

Dated: September 23, 2008   /George W. Luckhardt/
                                     George W. Luckhardt
                                     Reg. No. 50,519

George W. Luckhardt
Kyocera Wireless Corp.
Attn: Patent Department
P.O. Box 928289
San Diego, California 92192-8289
Tel: (858) 882-2593
Fax: (858) 882-4221